

REMARKS

Claims 39-71 were presented for examination. The applicants respectfully request reconsideration in light of the following comments.

Response to Restriction/Election Requirement

According to pg. 2 of the present Office Action, the Office alleged that the claims lack "*Unity of Invention*" because the present application contains more than one group of inventions "which are not so linked as to form a single general inventive concept under PCT Rule 13.1." The Office requires the applicants to elect one of the following groups for prosecution:

- **Group I:** Claims 39-51, drawn to an imaging processing system that uses convolution, classified in class 382, sub-class 279;
- **Group II:** Claims 52-54, drawn to an imaging processing system that uses image segmentation, classified in class 382, sub-class 173; and
- **Group III:** Claims 55-71, drawn to an imaging processing system that uses statistical decision processing, classified in class 382, sub-class 228.

The applicants respectfully disagree with the Office's conclusion with respect to Unity of Invention for at least the reasons discussed below.

Inconsistent Application of PCT Rule 13.1 Between Offices

In accordance with the *Manual of Patent Examination Procedures (MPEP)*, Chapter 1800, under Section 1850 "*Unity of Invention; II. Determination of Unity of Invention*":

From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. (emphasis supplied)

The present US application claims priority under 35 U.S.C. § 371 to international patent application No. PCT/EP2004/000831. In this regard, neither the International Searching Authority (which was the European Patent Office) nor the European Patent Office (during National/Regional phase examination) raised a "Unity of Invention" objection under PCT Rule 13.1 of the subject matter claimed in the international application — which is

essentially the same subject matter that is being claimed in the present U.S. application under consideration.

Moreover, it is notable that European Patent EP 1 709 587 B1 has already been granted with practically the same subject matter claimed in the EP patent and the pending claims of the present U.S. application.

The fact that the U.S. application is now being examined in the U.S. is no reason for a different result, since it is not U.S. “restriction/election” practice that governs, but rather PCT “Unity of Invention” practice:

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. (emphasis supplied)

(See, MPEP Chapter 1800, Section 1850, under “I. The Requirement for Unity of Invention”)

With all due respect to the Office, in a case such as this one in which there is a conflict between the EPO (as the ISA and subsequent national state examination authority) and the USPTO with regard to “Unity of Invention” analysis, the EPO analysis should govern. Unity of Invention is the standard by which the EPO practices; this is not true of the USPTO. Likewise, whereas a U.S. Examiner is likely to be influenced by U.S. restriction/election practice, that is not true for an EPO Examiner.

For at least the reasons discussed above, the applicants respectfully submit that the restriction/election requirement of the present application should be withdrawn.

Provisional Election

As is required for a complete response, the applicants ***provisionally*** elect the following group for examination with ***traverse***:

- **Group I:** Claims 39-51, drawn to an imaging processing system that uses convolution, classified in class 382, sub-class 279.

The applicants provisionally elect with traverse for at least the reasons discussed above.

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Respectfully,
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